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PATENT APPLICATION

REMARKS

Claims 1-3 and 5-24 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the previously cited reference, Byrne (U.S. Pat. No. 6,336,862).

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Applicant thanks the Supervisory Patent Examiner, Mr. Sough, for orally granting the telephonic interview request on April 13, 2004. Mr. Sough has communicated to the undersigned that the ideal time for the telephonic interview would be after April 26, 2004 and that Examiner Nga Nguyen will contact the undersigned after receiving and discussing the
10 interview request with Mr. Sough. The undersigned can be reached at 650-331-8413, 10AM-7PM PST, Monday-Friday.

The purpose of the requested telephonic interview is to accelerate prosecution and forward the present application to allowance. Applicant respectfully submits that, as a whole, Byrne
15 does not teach or suggest the claimed invention, as discussed in the previous Reply and shown by examples in the Appendix A attached thereto. Therefore, axiomatically, Byrne cannot and does not teach or suggest the steps/limitations recited in the claims.

MPEP § 2141.02 - Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering *both*
20 the invention and the prior art references as a whole. See also, MPEP § 2111 - § 2116.01.

The patentable novelty which the Applicant thinks the claims present in view of the of the state of the art disclosed by Byrne is that the present invention enables real iterative betting
25 for the first time [see, e.g., Reply A, page 9; see also, "Byrne as well as other cited prior art

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does not teach or suggest, *inter alia*, iterative betting against each other based on supply and demand principles", Reply A, page 14]. The original claims were amended as to form [Reply A, page 7]. Similarly, the amendments proposed herein make certain innate characteristics explicit.

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The novel features/properties upon which the Applicant relied in the Reply A are inherent to the limitations already recited in the claims and cannot be considered separately from the invention.

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"In determining whether the invention as a whole would have been obvious under 35 U.S.C. 103, we must first delineate the invention as a whole. In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification. . . Just as we look to a chemical and its properties when we examine the obviousness of a composition of matter claim, it is this invention *as a whole*, and not some part of it, which must be obvious under 35 U.S.C. 103." *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6,8 (CCPA 1977) (emphasis in original) (citations omitted).

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Since the final Office action did not rebut or dispute all of the arguments (new or improved results, functions, or effects) raised in the previous Reply, if it is the examiner's considered opinion that the asserted advantages are not sufficient to overcome the rejection(s) of record, he or she should state the reasons for his or her position in the record. By so doing the Applicant will know that the asserted advantages have actually been considered by the examiner and, if appeal is taken, the Board of Patent Appeals and Interferences will also be advised. [MPEP 707.07(f)].

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"The importance of answering applicant's arguments is illustrated by *In re Herrmann*, 261 F.2d 598, 120 USPQ 182 (CCPA 1958) where the applicant urged that the subject matter claimed produced new and useful results. The court noted that since applicant's statement of advantages was not questioned

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by the examiner or the Board of Appeals, it was constrained to accept the statement at face value and therefore found certain claims to be allowable. See also *In re Soni*, 54 F.3d 746, 751, 34 USPQ2d 1684, 1688 (Fed. Cir. 1995) (Office failed to rebut applicant's argument)." (*id.*)

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Furthermore, 37 CFR § 1.104 requires that the examiner's action will be complete as to all matters. The examiner must address all arguments which have not already been responded to in the statement of the rejection [MPEP 707.07]. The examiner must also address any arguments presented by the applicant which are *still relevant* to any references being applied

10 [*id.*].

"In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application. ... Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." [MPEP 707.07(f)].

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Absent rebuttal arguments/evidence to the contrary, claims that properly define the invention should be allowed.

20 "[T]he examiner should never overlook the importance of his or her role in allowing claims which properly define the invention." [MPEP 706].

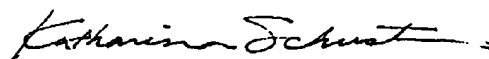
In sum, the claimed invention has been submitted to be unobvious over Byrne under
25 applicable laws [Reply A, Pages 8-14, Appendix A]. At the time of the invention, one skilled in the art would have readily recognized that Byrne's collateral Super Keno and Applicant's iterative betting are genuinely two entirely different inventions, extraneous to each other.

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To resolve any remaining issues and forward the present application to allowance, granting of the telephonic interview is respectfully requested and much appreciated. The undersigned can be reached at 650-331-8413, 10AM-7PM PST, Monday-Friday.

Respectfully submitted,



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